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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/574,919	01/08/2007	Mats Gustafsson	05822.0336USWO	5539
23552	7590	02/20/2009	EXAMINER	
MERCHANT & GOULD PC			HANSEN, JONATHAN M	
P.O. BOX 2903				
MINNEAPOLIS, MN 55402-0903			ART UNIT	PAPER NUMBER
			2886	
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			02/20/2009	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/574,919	GUSTAFSSON ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	JONATHAN M. HANSEN	2886	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 17 November 2008.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-8 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-8 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 07 May 2006 is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ .  | 6) <input type="checkbox"/> Other: _____ .                        |

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1, 2, and 4-6** are rejected under 35 U.S.C. 102(b) as being anticipated by **US Publication 2005/0046858 to Hanson et al.**

In regards to claim 1, Hanson discloses a method of determining the refractive index of an object compared to a refractive index of a surrounding medium, wherein:

exposing said object to a laser object beam and letting the object beam interfere with a laser reference beam, wherein said laser object beam and said laser reference beam have the same wavelength (par. 40);

detecting said interference by forming a hologram (par. 40),

analyzing the hologram for phase information (par. 44); and  
determining if the refractive index of the object is higher or lower than the refractive  
index of the surrounding medium based on said phase information (par. 44, 47, 49 and 78).

In regards to claim 2, Hanson discloses the method, wherein the step of analyzing and  
the step of determining are performed by a computer (par. 58 and 81).

In regards to claim 4, Hanson discloses and shows in Figure 61 below, a device for  
determining the refractive index of an object compared to a refractive index of a surrounding  
medium, said device comprising:

a laser (610) for exposing said object (630) to a laser object beam and letting the object  
beam interfere with a laser reference beam, wherein said laser object beam and said laser  
reference beam have the same wavelength (par. 62 and 63);

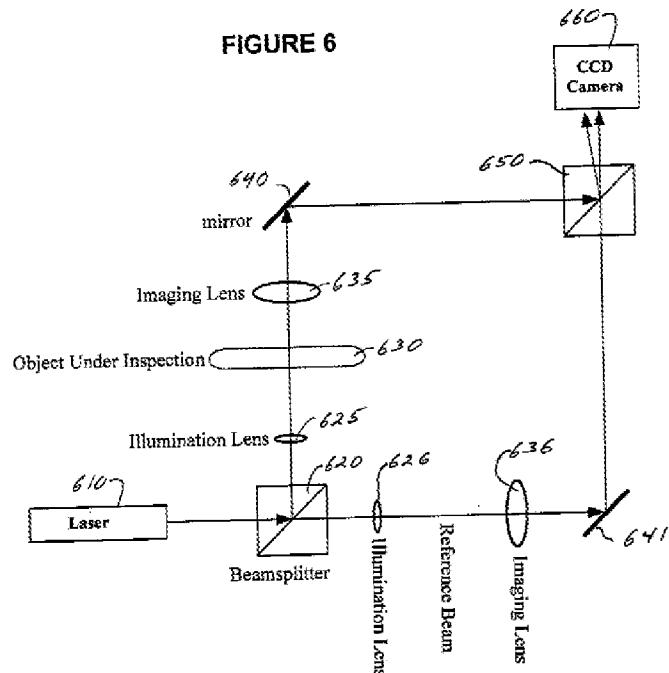
a CCD (660) (applicant's detector) for detecting said interference by forming a hologram  
(par. 30);

a desktop computer (par. 58, ll. 23-26) (applicant's computer) for analyzing the hologram  
for phase information, and for determining if the refractive index of the object is higher or lower  
than the refractive index of the surrounding medium based on said phase information (par. 33,  
44, 47 and 78).

Further, while features of an apparatus may be recited either structurally or functionally,  
claims directed to an apparatus must be distinguished from the prior art in terms of structure

rather than function. Limitations following "configured to," "adapted for," "designed to," "can be," "for," and "capable of," or are statements of intended use are not positive limitations and thus are not given patentable weight. See MPEP 2111.04 and 2114.

FIGURE 6



In regards to claim 5, Hanson discloses and shows in Figure 4B below, the device, wherein:

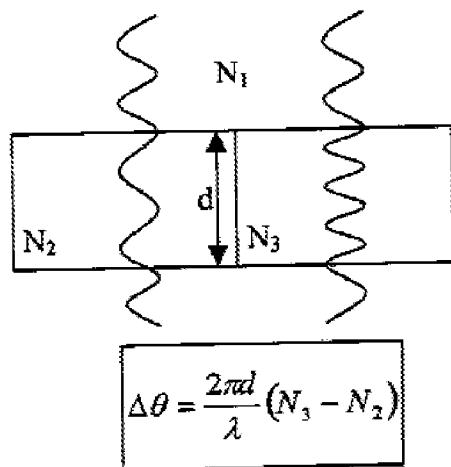
said object comprises particles of a first substance having a first refractive index (N2) and a second substance having a second refractive index (N3) and a medium having a refractive index (N1) between said first and second refractive indices (par. 49); and wherein  
 said computer recovers phase and amplitude data of the substances present in the object (par. 33).

Further, while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function.

It is also understood, that while the object under test is a significant portion of claim 5, it has been held that the material or article worked upon does not limit apparatus claims. Therefore, the limitations to the object are given no patentable weight. See MPEP 2115.

Also, limitations following “configured to,” “arranged to,” “adapted for,” “designed to,” “can be,” “for,” and “capable of,” or are statements of intended use are not positive limitations and thus are not given patentable weight. See MPEP 2111.04 and 2114.

## FIGURE 4B



In regards to claim **6**, Hanson discloses a computer program arranged on a computer readable medium for execution on a computer, the computer program including instructions which, when executed, perform the method (81).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims **3, 7 and 8** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Hanson**, in view of **US Patent 5,793,485 to Gourley**.

In regards to claim **3**, Hanson discloses and shows in Figure 4B above, the device, wherein:

said object comprises particles of a first substance having a first refractive index (N2) and a second substance having a second refractive index (N3) and a medium having a refractive index (N1) between said first and second refractive indices (par. 49).

Hanson is silent to counting the number of particles having a first refractive index and counting the number of particles having a second refractive index in a specific area of said sample.

However, Gourley teaches a resonant cavity apparatus that determines particle size, shape, identification or other characteristics of cells or particles, as well as a means for manipulating, sorting or eradicating cells (abstract).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hanson to include the separation and counting particles in a particle blend and calculating the volume ratio between particles in a particle blend for the advantage of high-speed, automated analysis of cells and/or particles, as taught by Gourley.

In regards to claims **7 and 8**, Hanson is silent to the method further comprising separating particles in a particle blend, counting particles in a particle blend and calculating the volume ratio between particles in a particle blend.

However, Gourley teaches a resonant cavity apparatus that determines particle size, shape, identification or other characteristics of cells or particles, as well as a means for manipulating, sorting or eradicating cells (abstract).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hanson to include the separation and counting particles in a particle blend and calculating the volume ratio between particles in a particle blend for the advantage of high-speed, automated analysis of cells and/or particles, as taught by Gourley.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JONATHAN M. HANSEN whose telephone number is (571)270-1736. The examiner can normally be reached on Monday through Friday 9:30AM to 6:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tarifur Chowdhury can be reached on 571-272-2287. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JMH 02/16/2009

/TARIFUR R CHOWDHURY/  
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